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10/799,387	03/12/2004	Miles Lasater	H01.002U	7249
27267	7590	08/05/2008	EXAMINER	
WIGGIN AND DANA LLP			APPLE, KIRSTEN SACHWITZ	
ATTENTION: PATENT DOCKETING			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/799,387	Applicant(s) LASATER ET AL.
	Examiner KIRSTEN S. APPLE	Art Unit 3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 23 April 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
 6) Other: _____

Detailed Action

This action is in response to the application filed on 4/23/08.

Priority

Acknowledgment is made of applicant's claim for prior priority date of U.S. Provisional Patent Application 60/458,671 filed on 03/28/2003 & 60/350,255 on 1/17/2002.

Acknowledgment is made of applicant's claim for prior continuation-in-part of the prior of Application No. 10/345,605 filed 1/16/2003 now patent 7,249,096.

Restriction

Examiner acknowledges the applicant election of Group I (Claims 1-27) in response to the election/restriction requirement, without traverse.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent Application 11/832,512.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims speak to students receiving funds from educational institution.

Regarding independent claim 1-2, the language within this claim can be found within claim 1 U.S. Patent Application 11/832,512.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to claims 1-23 Examiner finds these claims lack structure. A new interpretation at the Patent Office is that all methods claims must have structure such as on a "computer readable medium". The examiner is willing to during an interview discuss possible wording solutions to this issue.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eda (U.S. Patent Publication 2002/0152162) in view of Boesch (U.S. Patent 6,092,053)

Re claim 1: Eda discloses:

A method comprising:

Receiving from a supplier an indication of a refund amount associated with a buyer (see Eda, Figure 22)

Determining a method of refund delivery associated with the buyer; and automatically arranging for the refund amount to be provided to the buyer in accordance with the determined method of delivery. (see Eda, Figure 22)

Although Eda does not have Student/educational institution, Boesch claims “Student/educational institution” (see Bocach, column 19, claim 100)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eda by adapting Student/educational institution of Boesch.

It is clear that one would be motivated to apply to more specific example.

Note add additional claims will use student and educational institution for buyer and supplier respectively based on the explanation of claim 1.

Re claim 2: Eda discloses:

Method of delivery comprises one of:

Electronic transfer of refund amount to a bank account associated with the student (see Eda, Figure 22, item S2209-S2211, paragraph 0163)

A paper check mailed to an address associated with the student

Transfer of the refund amount to a credit account associated with the student

Re claim 3: Eda discloses:

Wherein a total refund amount is transferred from an account associated with the educational institution to a group holding account at a facilitating bank, the total refund amount representing refunds for a plurality of students, and further comprising: providing information to the bank indicating a set of students along with a portion of the total refund amount associated with each student. (see Eda, Figure 22)

Re claim 4: Eda discloses:

Wherein a total refund amount is transferred from an account associated with the educational institution to an escrow account, the total refund amount representing refunds for a plurality of students, and further comprising: arranging for the total refund amount to be transferred from the escrow account to a group holding accounts; and providing information to the bank indicating a set of students along with a portion of the total refund amount associated with each student. (see Eda, Figure 22 & 8)

Re claim 5: Eda discloses:

Wherein a plurality of refund amounts are transferred from an account associated with the educational institution to a plurality of temporary holding accounts associated with a plurality of students. (see Eda, Figure 22 & 8)

Re claim 6: Eda discloses:

Wherein a total refund amount is transferred from an account associated with the educational institution to an escrow account at a bank, the total refund amount representing refunds for a plurality of students, the method further comprising: instructing the bank to

transfer from the escrow account a first refund amount associated with a first student (see Eda, Figure 22 & 8)

Re claim 7: Eda discloses:

Wherein the bank is to transfer the first refund amount from the escrow account to one of:

- i- a temporary holding account (see Eda, Figure 8 escrow account)*
- ii – a bank account associated with the first student at another bank via an electronic funds transfer,*
- iii- the student via a paper check sent via postal mail*
- iv- a non-temporary account associated with the first student at the bank*

Re claim 8: Eda discloses:

Wherein the received indication includes at least one of

- i- an educational institution identifier*
- ii – a student identifier*
- iii – an indication of the refund amount (see Eda, figure 11, “order volume”)*

Re claim 9: Eda discloses:

Further comprising:

Verifying the received indication (see Eda, figure 17, item S1709)

Re claim 10: Eda discloses:

Wherein the verifying includes at least one of:

- i- comparing refund amounts associated with a plurality of students to an amount currently available to an escrow account (see Eda, paragraph 0119)*

- ii- comparing the refund amount to a pre-determined threshold limit*
- iii- comparing a student identifier with a list of existing student identifiers*
- iv- calculating a hash value associated with the received indication and*
- v- calculating a checksum associated with the received indication*

Re claim 11: Eda discloses:

Further comprising: generating a refund information report (see Eda, figure 20, item S2028 & figure 21)

Re claim 12: Eda discloses:

Further comprising: performing a refund information search (see Eda, paragraph 0122)

Re claim 13: Eda discloses:

Wherein the educational institution is associated with at least one of

i- a university (see Bocach, column 19, claim 100)

ii - a college

iii- a technical school

iv- a professional education program

v – a government training program

vi- an on-line educational program

(see Eda, figure , item , pg , column, line)

Re claim 14: Eda discloses:

Further comprising: receiving from the student an indication of a preferred method of delivery (see Eda, figure 5, Item S 523)

Re claim 15: Eda discloses:

Wherein the indication is received from the student via a communication network (see Eda, figure 1)

Re claim 16: Eda discloses:

Wherein the preferred method of delivery comprises deposit to a bank account previously distributed to the student via the educational institution. (see Eda, figure 3)

Re claim 17: Eda discloses:

Wherein the bank account is associated with a student identification card. (see Eda, figure 2, item S207)

Re claim 18: Eda discloses:

Further comprising: reviewing, via the educational institution, information associated with the student; and arranging for the bank account to be created for the student based on the received information. (see Eda, figure 2, item S207)

Re claim 19: Eda discloses:

Wherein the bank account comprises at least one of:

i-a demand deposit account

ii- a negotiable order of withdrawal account

iii- a money market account

iv- a savings account (see Eda, figure 3, “savings type”)

v- an asset management account and

vi- a brokerage account

Re claim 20: Eda discloses:

Wherein the arranging comprises:

Establishing a soft bank account based on the received information: receiving an indication of acceptance associated with the member; and activating the soft bank account in response to the received indication. (see Eda, figure 3 & 8)

Re claim 21: Eda discloses:

Wherein the indication of acceptance includes security information. (see Eda, figure 3)

Re claim 22: Eda discloses:

Wherein the indication of acceptance is received via at least one of:

i-the member (see Eda, figure 2, item s206)

ii- the educational institution

iii- a merchant

iv- a public network

v- a private network

vi- a telephone call

vii- the internet

and

viii- a representative

Re claim 23: Eda discloses:

Wherein the received information comprises at least one of

Social security number

A member identification number

A name (see Eda, figure 3, “user name”)

A date of birth

An address

A telephone number

A student/local address

A student/local telephone number

A graduation data

A status

A major

An electronic mail address

A drivers license number

A passport number

Citizenship information

Barcode information

A parent's name

A parents address

Image information

An educational institution indicator (see Eda, figure , item , pg , column, line)

Re claim 24: Eda discloses:

An apparatus comprising:

A process (see Eda, figure 1, item 3 & 4)

And a storage device (see Eda, figure 1, item 55 & 56)

See claim 1 for additional limitations

Re claim 25: Eda discloses:

Storage device:

Student database (see Eda, figure 1, item 55)

Refund database (see Eda, figure , item , pg , column, line)

Re claim 26: Eda discloses:

A communication device coupled to a processor and adapted to communicate with:

A refund controller (see Eda, figure 1, item 5)

An educational institution device (see Eda, figure 1, item 4)

A member device (see Eda, figure 1, item 3)

A bank device (see Eda, figure 1, item 5)

Re claim 27: Eda discloses:

A medium storing instructions adapted to be executed by a process to perform a method

(see Eda, figure 1, item 5)

See claim 1 for additional limitations

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Art Unit: 3694

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa

/Kirsten S Apple/
Examiner, Art Unit 3694